

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

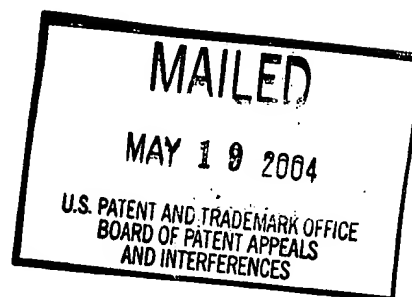
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ELLEN K. WESEL

Appeal No. 2002-1836  
Application 09/159,817

ON BRIEF



Before HAIRSTON, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-10. Claims 11-30 stand withdrawn from consideration by the examiner as a result of a restriction requirement.

The disclosed invention pertains to a satellite system operating over a land mass.

Representative claim 1 is reproduced as follows:

1. A satellite system operating over a land mass comprising:

a first satellite generating a first plurality of spot beams directed at said land mass, said first set of spot beams partially covering said land mass;

a second satellite generating a second plurality of spot beams;

said first plurality of spot beams and said second plurality of spot beams in combination provide substantially ubiquitous coverage over the land mass.

The examiner relies on the following references:

Rouffet et al. (Rouffet)	5,410,731	Apr. 25, 1995
Diekelman	5,612,701	Mar. 18, 1997
Lynch	6,002,916	Dec. 14, 1999
		(filed Feb. 23, 1998)

Claims 1, 5 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Rouffet. Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Rouffet in view of Lynch. Claims 7-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Rouffet in view of Diekelman.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

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OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon by the examiner does not support the rejections made by the examiner. Accordingly, we reverse.

We consider first the rejection of claims 1, 5 and 6 as being anticipated by the disclosure of Rouffet. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Associates, Inc.

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v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he finds the claimed invention to be fully met by the disclosure of Rouffet [answer, page 3]. With respect to independent claim 1, appellant argues that Rouffet fails to teach or suggest a first plurality of spot beams providing partial coverage over a land mass and a second plurality of spot beams that together provide ubiquitous coverage over the land mass as recited in claim 1. Specifically, appellant argues that the two areas covered by the two satellites in Rouffet are separate and distinct areas and, therefore, Rouffet does not provide ubiquitous coverage as claimed. The examiner responds that Rouffet teaches that both satellites cover the same land mass. The examiner also notes that Rouffet teaches a medium power amplifier which leads to a low power amplification and provides partial coverage over a landmass. Finally, the examiner responds that the land coverage in Rouffet reads on substantially ubiquitous [answer, pages 5-7]. Appellant responds that the two areas T1 and T2 of Rouffet are separate and ubiquitous coverage cannot be provided [reply brief, pages 1-2].

We will not sustain the anticipation rejection of claim 1. Any analysis has to begin with the language of the claim and how that language is to be interpreted. In the rejection, the examiner reads "the first plurality of spot beams" on F1 and F2 and the "land mass" on T1 and T2 of Rouffet. Although the examiner asserts that the first plurality of spot beams partially covers the land mass, the spot beams F1 and F2 in Rouffet cover the entire land mass if it is defined as T1 plus T2 rather than the partial coverage as claimed. In the response to arguments section of the answer, the examiner appears to read the land mass on area T1 only and asserts that satellites S1 and S2 both cover this land mass. In this situation as well, however, the spot beams from S1 and S2 cover the entire land mass. In the response to arguments section of the answer, the examiner also attempts to address this partial cover limitation by discussing the low and medium amplification power of the amplifiers. The examiner has not clearly explained how the power amplification relates to the question of satellite coverage, and we are unable to discern from the examiner's analysis how the system of Rouffet meets the claim limitation of a first satellite generating a plurality of spot beams which partially covers the land mass. With respect to appellant's argument regarding the claimed ubiquitous coverage

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over the land mass, if the land mass in Rouffet is considered to include areas in addition to T1 and T2, then Rouffet would not provide ubiquitous coverage as claimed. Since claims 5 and 6 depend from claim 1, we also do not sustain the anticipation rejection of these claims.

We now consider the rejections of claims 2-4 and 7-10 under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert.

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denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444

(Fed. Cir. 1992). If that burden is met, the burden then shifts

to the applicant to overcome the prima facie case with argument

and/or evidence. Obviousness is then determined on the basis of

the evidence as a whole and the relative persuasiveness of the

arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ

685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,

223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d

1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments

actually made by appellant have been considered in this decision.

Arguments which appellant could have made but chose not to make

in the brief have not been considered and are deemed to be waived

[see 37 CFR § 1.192(a)].

Each of the claims subject to rejection under 35 U.S.C.

§ 103 depends from and incorporates the limitations of

independent claim 1. For reasons discussed above, Rouffet does

not teach or suggest all the limitations of claim 1. The

examiner relies on Rouffet as the primary reference in rejecting

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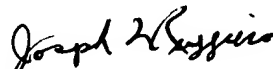
all the claims on appeal. Because Rouffet does not support the teachings relied on by the examiner, the examiner has failed to establish a prima facie case of obviousness. We also note that the secondary references Lynch and Diekelman fail to overcome the deficiencies in the primary reference Rouffet. Therefore, we do not sustain the rejection of 2-4 and 7-10.

In summary, we have not sustained any of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-10 is reversed.

REVERSED

  
KENNETH W. HAIRSTON  
Administrative Patent Judge )

  
JERRY SMITH  
Administrative Patent Judge )

  
Joseph F. Ruggiero  
Administrative Patent Judge )

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